

Translation

PATENT COOPERATION TREATY

PCT

PCT/EP2003/012116



534,347

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

|   |   |   |
|---|---|---|
| Applicant's or agent's file reference<br>LKG 003/2002 PCT                                   | <b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416) |   |
| International application No.<br>PCT/EP2003/012116  | International filing date (day/month/year)<br>31 October 2003 (31.10.2003)  | Priority date (day/month/year)<br>14 November 2002 (14.11.2002) |
| International Patent Classification (IPC) or national classification and IPC<br>C08F 220/18 |   |   |
| Applicant<br>LOHMANN GMBH & CO.KG   |   |   |

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|--|
| 1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.  |
| 2. This REPORT consists of a total of <u>6</u> sheets, including this cover sheet.<br><br><input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).<br><br>These annexes consist of a total of <u>5</u> sheets.  |
| 3. This report contains indications relating to the following items:<br><br>I <input checked="" type="checkbox"/> Basis of the report<br>II <input type="checkbox"/> Priority<br>III <input checked="" type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability<br>IV <input checked="" type="checkbox"/> Lack of unity of invention<br>V <input checked="" type="checkbox"/> Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement<br>VI <input type="checkbox"/> Certain documents cited<br>VII <input type="checkbox"/> Certain defects in the international application<br>VIII <input type="checkbox"/> Certain observations on the international application |

|  |  |
|--|--|
| Date of submission of the demand<br>10 March 2004 (10.03.2004) | Date of completion of this report<br>16 February 2005 (16.02.2005) |
| Name and mailing address of the IPEA/EP                        | Authorized officer   |
| Facsimile No.  | Telephone No.  |

# INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/EP2003/012116

## I. Basis of the report

### 1. With regard to the elements of the international application:\*

- ☐ the international application as originally filed
- ☒ the description:  
 pages 1-5, 7-13, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages 6, filed with the letter of 02 September 2004 (02.09.2004)
- ☒ the claims:  
 pages \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, as amended (together with any statement under Article 19  
 pages \_\_\_\_\_, filed with the demand  
 pages 1-15, filed with the letter of 19 January 2005 (19.01.2005)
- ☐ the drawings:  
 pages \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_
- ☐ the sequence listing part of the description:  
 pages \_\_\_\_\_, as originally filed  
 pages \_\_\_\_\_, filed with the demand  
 pages \_\_\_\_\_, filed with the letter of \_\_\_\_\_

### 2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language \_\_\_\_\_ which is:

- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

### 3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

### 4. ☐ The amendments have resulted in the cancellation of:

- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, Nos. \_\_\_\_\_
- ☐ the drawings, sheets/fig \_\_\_\_\_

### 5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).\*\*

\* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rule 70.16 and 70.17).

\*\* Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

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## III. Non-establishment of opinion with regard to novelty, inventive step and industrial applicability

1. The questions whether the claimed invention appears to be novel, to involve an inventive step (to be non obvious), or to be industrially applicable have not been examined in respect of:

- ☐ the entire international application.
- ☒ claims Nos. 9-12, 14, 15

because:

- ☐ the said international application, or the said claims Nos. \_\_\_\_\_  
relate to the following subject matter which does not require an international preliminary examination (*specify*):

- ☐ the description, claims or drawings (*indicate particular elements below*) or said claims Nos. \_\_\_\_\_  
are so unclear that no meaningful opinion could be formed (*specify*):

- ☐ the claims, or said claims Nos. \_\_\_\_\_ are so inadequately supported  
by the description that no meaningful opinion could be formed.
- ☒ no international search report has been established for said claims Nos. 9-12, 14, 15.

2. A meaningful international preliminary examination cannot be carried out due to the failure of the nucleotide and/or amino acid sequence listing to comply with the standard provided for in Annex C of the Administrative Instructions:

- ☐ the written form has not been furnished or does not comply with the standard.
- ☐ the computer readable form has not been furnished or does not comply with the standard.

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IV. Lack of unity of invention

1. In response to the invitation to restrict or pay additional fees the applicant has:

- ☐ restricted the claims.
- ☐ paid additional fees.
- ☐ paid additional fees under protest.
- ☒ neither restricted nor paid additional fees.

2. ☒ This Authority found that the requirement of unity of invention is not complied with and chose, according to Rule 68.1, not to invite the applicant to restrict or pay additional fees.

3. This Authority considers that the requirement of unity of invention in accordance with Rules 13.1, 13.2 and 13.3 is

- ☐ complied with.
- ☐ not complied with for the following reasons:

4. Consequently, the following parts of the international application were the subject of international preliminary examination in establishing this report:

- ☐ all parts.
- ☒ the parts relating to claims Nos. 1 (IN PART), 2-8, 13 (IN PART)

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT 03/12116

**I. Basis of the report**

1. This report has been drawn on the basis of *(Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.)*:

1. This report is for claims 1 (in part), 2 to 8 and 13 (in part) of the application (see Boxes IV and V).

**Supplemental Box**

(To be used when the space in any of the preceding boxes is not sufficient)

Continuation of: IV

**Lack of unity of invention**

1. These amendments to the present claims are the third version for the application. As described in Box V of this report with regard to claim 1, the present application lacks unity of invention (PCT Rule 13.1). The applicant has not paid the additional search fees required for the application on time. The international search report is therefore limited to the invention first mentioned in the claims; this invention is covered in the following claims: 1 (in part), 2 to 8 and 13 (in part).

## INTERNATIONAL PRELIMINARY EXAMINATION REPORT

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**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

## 1. Statement

|                               |        |                                |     |
|-------------------------------|--------|--------------------------------|-----|
| Novelty (N)                   | Claims |                                | YES |
|                               | Claims | 1 (in part), 2-8, 13 (in part) | NO  |
| Inventive step (IS)           | Claims |                                | YES |
|                               | Claims | 1 (in part), 2-8, 13 (in part) | NO  |
| Industrial applicability (IA) | Claims | 1 (in part), 2-8, 13 (in part) | YES |
|                               | Claims |                                | NO  |

## 2. Citations and explanations

1. This report makes reference to the following documents D1 to D3; the same numbering will be used throughout the proceedings:

D1: EP0039797

D2: EP0735122

D3: EP0413301

2. With regard to the new amendments, in particular with regard to claim 1:

The Examining Authority has noted that the present/current claim 1 does not disclose only the features of claim 3 in the originally submitted version. The Examining Authority is therefore of the opinion that the additional phrase in claim 1, in particular in claim 1 (a), "and the reaction product ...imino, urethane, ... etc." has been modified by the addition of features of claims 10, 11 and 12 in the originally submitted version.

It should be noted that no international search report has been established for claims 10, 11, 12, etc. in the originally submitted version (lack of unity of invention).

The applicant has not paid the additional search fees required for the other inventions on time. The

international search report is therefore limited to the invention first mentioned in the claims; this invention is covered in the following claims: 1 (in part), 2 to 8 and 13 (in part).

3. D1 discloses a polymer composition that can be produced by the polymerization of (a) 1 to 50 wt.% polar (meth)acrylates with Zerewitinoff hydrogen, selected from the group comprising 2-hydroxyethyl(meth)acrylate, 3-hydroxypropyl-(meth)acrylate, 4-hydroxybutyl-(meth)acrylate, PEG-(meth)acrylate, PPG-(meth)acrylate, 2-aminoethyl(meth)-acrylate, 3-amino-propyl(meth)acrylate and 4-aminobutyl-(meth)acrylate; and (b), (c), (d) and (e) as defined in claim 1.

In light of the disclosure in D1 (page 2, line 26 to page 9, line 9; page 4, lines 6-19, in particular lines 15-19; page 4, lines 23-26; page 4, line 27 to page 5, line 13, in particular page 5, lines 11-13; page 3, lines 26-29), the subject matter of claims 1 (in part), 2 to 8 and 13 (in part) does not appear to be novel (PCT Article 33(2)).

In light of the disclosure in D2 (page 3, line 56 to page 6, line 4; claims 1-9; page 3, line 24 to page 4, line 35; examples), the subject matter of claims 1 (in part), 2 to 8 and 13 (in part) does not appear to be novel (PCT Article 33(2)).

In light of the disclosure in D3 (claims 5-7; page 2, line 13 to page 3, line 36; examples, claims 1 to 15), the subject matter of claims 1 (in part), 2 to 8 and 13 (in part) does not appear to be novel (PCT Article 33(2)).